



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,105	09/19/2001	Hiroatsu Kazama	040894-5715	9653

9629 7590 07/15/2005

MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER

MILIA, MARK R

ART UNIT	PAPER NUMBER
----------	--------------

2622

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/955,105

Applicant(s)

KAZAMA ET AL.

Examiner

Mark R. Milia

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/19/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 7B, reference character (730), Fig. 13, reference characters (321) and (322), and all of Fig. 14. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to because Figures 9-12 lack reference characters to which the steps put forth in the figures can be identified. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if

only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities: On page 17, line 4, "12" should read "13". The disclosure also lacks a detailed description of figures 9-12. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 9-13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5220674 to Morgan et al.

Regarding claim 1, Morgan discloses an image forming apparatus management system comprises: a client machine adapted to issue a job instruction including a job condition (see Fig. 1 (18), column 6 lines 17-20, column 6 line 55-column 7 line 5, and column 7 lines 11-19), an image forming apparatus having a parameter adjustment unit (print controller (29) in conjunction with resource manager (44)), the image forming apparatus being set a value of a parameter accordance with the job instruction (see Fig. 1 (16), column 6 lines 11-14 and 39-50, column 7 lines 20-29, and column 8 line 60-column 9 line 3), a host server having an external database storing a plurality values of the parameter corresponding to predetermined job conditions, respectively (see Fig. 1 (26), column 6 lines 39-50, column 7 lines 20-29, column 10 lines 38-40 and 48-51, and column 15 lines 19-33, reference shows a resource server containing a database of stored resources useful to the printers that is connect via a network to the client machines, which is analogous to the claim limitation), and a client server connected to the client machine, to the image forming apparatus, and to the host server, the client server enabling to communicate with the host server mutually (see Fig. 1 (10), the print server is analogous to the client server of the claim limitation as it serves the same purpose and function as that of the client server), wherein the client server transmits a external parameter request to the host server and transmits a value of the parameter

transmitted from the host server to the image forming apparatus (see Fig. 1, column 6 lines 39-50, column 7 lines 20-29, column 10 lines 38-40 and 48-51, and column 15 lines 19-33, reference shows that when a client transmits a print request that a printer does not possess the resource to properly complete, the printer sends a request to the print server to acquire the resource from either the resource server or the global database and then the desired resource is transmitted back to the printer, all of which is analogous to the claim limitation), and the host server retrieves a value of the parameter meeting the job condition from the external database to transmit the retrieved value of the parameter to the client server in response to the external parameter request (see Fig. 1, column 6 line 39-column 7 line 29, column 8 line 60-column 9 line 3, and column 9 lines 43-59).

Regarding claim 2, Morgan discloses the system discussed in claim 1, and further discloses wherein the parameter adjustment mechanism is a plurality of the parameter adjustment mechanisms (see Fig. 1 (29) and (44), column 8 line 60-column 9 line 3), and the parameter is a plurality of parameters (see column 6 line 39-column 7 line 29, column 7 lines 46-58, and column 10 lines 48-51).

Regarding claim 3, Morgan discloses the system discussed in claim 1, and further discloses wherein the client server transmits the external parameter request to the host server in response to a request by the client machine (see column 6 line 55-column 7 line 29, reference shows that when a client transmits a print request that a printer does not possess the resource to properly complete, the printer sends a request to the print server to acquire the resource from either the resource server or the global

database and then the desired resource is transmitted back to the printer, all of which is analogous to the claim limitation).

Regarding claim 4, Morgan discloses the system discussed in claim 1, and further discloses an internal data base storing a plurality of values of the parameter corresponding predetermined standard conditions, respectively, the internal data base disposed in one of the image forming apparatus, the client server, and the client machine (see Fig. 1 (29) and column 8 lines 60-63), wherein the client server determines whether the external data base is used or not (see column 7 lines 20-29 and column 8 line 63-column 9 line 3), when the external data base is used, the host server retrieves a value of the parameter meeting the job condition from the external database to transmit the retrieved value of the parameters to the client server in response to the external parameter request (see column 7 lines 11-29), when the external data base is not used, the client server retrieves a value of the parameter meeting the job condition from the internal database to transmit the retrieved value of the parameter to the image forming apparatus (see column 8 line 60-column 9 line 3).

Regarding claim 5, Morgan discloses the system discussed in claim 1, and further discloses wherein the host server periodically updates the external database (see column 7 lines 50-58 and column 8 lines 43-47).

Regarding claim 7, Morgan discloses the system discussed in claim 1, and further discloses wherein when the client server transmits the external parameter request to the host server, the host server transmits a condition item information of the external database to the client machine via the client server (see column 7 lines 11-29),

and when a predetermined job condition item is selected at the client machine, the host server transmits a value of the parameter meeting the selected job condition item (see column 7 lines 11-29 and column 8 line 60-column 9 line 3).

Regarding claim 9, Morgan discloses the system discussed in claim 1, and further discloses wherein the host server retrieves the value of the parameter meeting the job condition from the external database based on use condition of the image forming apparatus (see column 7 lines 11-29 and column 8 line 60-column 9 line 3).

Regarding claim 10, Morgan discloses the system discussed in claim 1, and further discloses wherein the client server transmits the value of the parameter transmitted from the host server to the image forming apparatus before the image forming apparatus starts a job (see column 8 line 60-column 9 line 3).

Regarding claim 11, Morgan discloses the system discussed in claim 1, and further discloses wherein after the client server transmits the value of the parameter transmitted from the host server to the image forming apparatus, the image forming apparatus automatically starts a job according to the job instruction from the client machine (see column 7 lines 11-29 and column 8 line 60-column 9 line 3).

Regarding claim 12, Morgan discloses the system discussed in claim 1, and further discloses wherein if the host server has transmitted the value of the parameter to the image forming apparatus via the client server, the host server can receive job result information from the image forming apparatus via the client server (see column 7 lines 11-19 and 30-42).



Regarding claim 13, Morgan discloses the system discussed in claim 1, and further discloses wherein the image forming apparatus is a printer to execute a print job (see Fig. 1 (16)).

Regarding claim 15, Morgan discloses the system discussed in claim 13, and further discloses wherein the printer has an image information measuring section adapted to measure an image information on result of the print job (see column 8 line 60-column 9 line 3), and the printer transmits the image information to the host server via the client server (see column 8 line 60-column 9 line 3).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan as applied to claim 5 above.

Regarding claim 6, Morgan does not disclose expressly wherein the client machine has a display section and the client machine can display whether the external database of the host server has been updated on the display section.

However, Morgan does disclose a client machine that can be used to add, delete, or modify the resources available to the printer (see Fig. 1, column 6 lines 17-38, and column 7 lines 50-58).

Regarding claim 8, Morgan does not disclose expressly wherein the client machine has a job condition item display section and the client machine can display the job condition item information of the external database transmitted from the host server on the job condition item display section.

However, Morgan does disclose a client machine that can be used to add, delete, or modify the resources available to the printer (see Fig. 1, column 6 lines 17-38, and column 7 lines 50-58).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a display device as part of the client machine and because the system as described by Morgan allows the user to add, delete, or modify the resources available to the printer, it would have been obvious to display this information on the client display device.

The suggestion/motivation for doing so would have been to allow the user to easily manipulate resource information and transmit print jobs to a printer utilizing a client machine with a display device, which is well known and commonly used in the art.

Therefore, it would have been obvious to modify Morgan to obtain the invention as specified in claims 6 and 8.

***Allowable Subject Matter***

6. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Examiner believes that the storing of a parameter corresponding to the brand of print sheets in the external database is not suggested in the reference of Morgan and is not an obvious addition to the reference.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art refer to U.S. Patent numbers 6515756 (Mastie et al.), 5537626 (Kraslavsky et al.), 5995723 (Sperry et al.), 6173295 (Goertz et al.), 6188487 (Matsubara), 6567176 (Jeyachandran et al.), 6798530 (Buckley et al.), and 5680615 and 5778377 (Marlin et al.).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark R. Milia  
Examiner  
Art Unit 2622

MRM

JOSEPA R. POKRZYWA  
PRIMARY EXAMINER  
ART UNIT 2622

*Joseph R. Pokrzywa*